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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,506	02/23/2004	Parul Agrawal	HSJ920030252US1	2172
48583	7590	08/23/2006	EXAMINER	
BRACEWELL & PATTERSON, LLP PO BOX 61389 HOUSTON, TX 77208-1389			HEINZ, ALLEN J	
			ART UNIT	PAPER NUMBER
			2627	
DATE MAILED: 08/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,506

Applicant(s)

AGRAWAL ET AL.

Examiner

A. J. HEINZ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) 2-7 and 10-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>8/16/06</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/23/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Addendums A&B</u> . |

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1. Applicant's election of the species of figure 2 (claims 1-13&22-31 readable thereon) in Paper dated 24 July 2006 is acknowledged. The election having been made without traverse.

Claims 14-21 have been canceled.

2. Upon further review of the claimed invention the following restriction requirement is made because the nature and scope of the invention is of such an extent as to require the separation of the different inventions for a complete and proper examination

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I; Claims 1-13 are drawn to the product of a slider for burnishing, classified in Class 360, subclass 235.4.

Group II; Claims 22-31 are drawn to a method of using the slider for burnishing, classified in Class 29, subclass 90.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using

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the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process as claimed for burnishing asperities from a media can use other significantly different sliders such as those that utilize abrasive patterns on the rails to achieve the cleaning of loose particles and/or devices which operate like sliders but do not have rail configurations and utilize other abrasive configurations to achieve the cleaning of loose particles.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and require divergent fields of search, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. M.E. Noe on 16 August 2006, a provisional election was made without traverse to prosecute the invention of group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-31 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

**The following is an office action on the patentable
merits of the instant application.**

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The Title should provide a more detailed structural identification of the feature or features which distinguish the invention from the prior art.

The intended results produced by the structural differences can also be part of the content of the Title but should be made subordinate to the structural differences.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Akiyama.

See Figures 2A{displays slider orientation relative to disc} and 15A. Note, to the extent claimed and understood, the structure as shown in Addendum A reads on and performs to the same degree as claimed.

8. Claims 1, 8 & 9 are rejected under 35 U.S.C. §102(b) as being anticipated by Bolasna.

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See Figure 13. Note, to the extent claimed and understood, the structure as shown in Addendum B reads on and performs to the same degree as claimed.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kasamatsu shows slider configurations that contact the magnetic media.

10. For a complete response applicant should identify how the claimed structure of his invention defines over **all** the art of record.

Moreover, where the applicant disagrees with the reasoning and/or application of the prior art on critical points of the claims, they should identify how the claimed structure of their invention defines over **all** the art of record not just the applied art.

Where applicant believes that the art is redundant and/or superfluous relative to the critical aspects of the claimed invention the applicant may simply state so in rebuttal summary.

11. Claims 2-7&10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

12. If applicant has filed an information disclosure statement and this instant office action does not contain an initialed-off copy (or copies) of all such filed IDS's (or at least a comment to the disposition of such IDS'S in the body of the office action itself) applicant should apprise the examiner of such missing documentation [to the IDS's] in response to this office action so that the examiner can take appropriate action to supply same to the applicant.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. J. HEINZ whose telephone number is (571) 272-7587. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DWAYNE BOST can be reached on (571)272-7023.

The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. J. HEINZ
Primary Examiner
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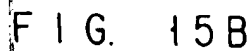
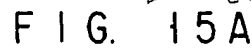
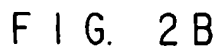


FIG. 13

